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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,546	05/21/1999	JAY S. WALKER	WD2-99-012	7943

22927 7590 04/09/2007
 WALKER DIGITAL MANAGEMENT, LLC
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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/316,546	Applicant(s) WALKER ET AL.	
	Examiner Stefano Karmis	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's arguments filed 16 January 2007.

Status of Claims

2. There are no new amendments to the claims. Claims 1-58 are currently pending.

Response to Arguments

3. Applicant's arguments filed 16 January 2007 have been fully considered but they are not persuasive as discussed below. Therefore claims 1-58 stand rejected and Applicant's request for allowance is respectfully declined.

Regarding claims 1-58, Applicant claims priority to application 08/920116. Applicant states that the Examiner initially determined that the 08/920116 application disclosed all of the subject matter of all the independent claims and that now the Examiner has changed his assessment of that application. In Response: The Examiner never determined that the 08/920116 application disclosed all of the subject matter of all the independent claims. Simply because the application was cited as a reference in a previous office action, does not constitute that the Examiner acknowledges that the application is valid for purposes of priority. Therefore the Examiner has not "changed his assessment" as suggested by the Applicant. Applicant has chosen not to agree or disagree with the Examiner's assertion that the disclosure of 08/920116 does not support the subject matter of the pending claims.

Regarding claims 1-58, Applicant argues that the prior art cited, Herman is not supported by the provisional application (hereinafter Herman PRO). The Examiner respectfully disagrees. Applicant has cited specific portions of the MPEP 2136.03, which state that "The 35 U.S.C. 102(e) critical reference date of a U.S. Patent ...entitled to the benefit of the filing date of the provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application...if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph." Since, Herman PRO properly supports the subject matter relied upon in the rejection in compliance with 35 U.S.C. 112, first paragraph, the rejection set forth by the Examiner is maintained.

Herman was relied on for the teachings related to smart receipts, generated at the conclusion of a successful transaction. These smart receipts allows for multiple offer types to be transmitted to the buyer in accordance with claims. The bulk of the relied upon teachings are found at column 43, line 9 thru column 45-28. Herman PRO clearly supports the cited portions. HERMAN PRO teaches that a trusted agent service is an Internet-based mechanism that makes single-click buying available on commercial Web sites (page 8). The trusted agent provides smart receipts used for ongoing customer support (page 8). HERMAN PRO further teaches that a relationship marketing server uses smart receipts as the basis for after-market consumer care (page 9). The customer can open a trusted agent and click on a smart receipt and be presented with a number of services, including pre-formatted and routed requests for related products (page 10). Clearly these services qualify as a benefit to the customer. HERMAN PRO also teaches the use of LEDOs (pages 12-13) used for communicating the trusted agent server with the business server.

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These passages clearly support the cited passages in Herman regarding “the buyer can, at any time, examine the smart receipt and check for merchant specials, discounts or value-added services (column 44, lines 5-20); that Smart Receipts are kept secure on the Trusted Agent Server (column 44, lines 33-37); and that LEDOs are used in the processing of communication (column 43, lines 43-67). Therefore the passages support the subject matter relied upon in accordance with 35 U.S.C. 112, first paragraph. The language meets both the written description requirement and the enablement requirement since it enables one of ordinary skill in the art to make and use the invention. Therefore Applicant’s arguments with respect Herman and Herman PRO are not persuasive.

Applicant argues that claim 56 is not taught by Herman because Herman fails to teach a record of charge for a transaction printed by a point-of-sale terminal. In Response: The Examiner respectfully disagrees. Herman teaches a direct response server wherein redemptions can be printed on paper and taken for redemption at an actual retailer (column 38, lines 9-24). This is supported in Herman Pro on page 9. Further, Herman teaches that conventional receipts can be printed (column 1, lines 25-33) and that the Smart Receipt offers things above and beyond the conventional receipt.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted

Stefano Karmis

27 March 2007



HANI M. KAZIMI
PRIMARY EXAMINER